

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 5-13 and 19-30 will be active in the application subsequent to entry of this Amendment.

Discussion of Amendments to the Claims

The claims have been amended in order to more particularly point out and distinctly claim that which applicants regard as their invention and to advance examination generally.

Claims 14-18, withdrawn from consideration as directed to non-elected subject matter, have been canceled, it being understood that this action is without disclaimer or without prejudice to a divisional application directed to the subject matter of these claims.

Claims 1-4 have been canceled while claims 5-13, directed to elected and examined subject matter, remain in the application unamended.

Claims 19-30 have been added directed to preferred aspects of the description and in particular when the surface coating layer is composed of at least one material selected from a fatty acid, a fatty acid metal salt or a coupling agent which, in turn, leads to improved abrasion resistance.

Applicants have recognized that abrasion resistance is an important aspect of a successful road marking material, a property that is often lacking from prior suggestions and descriptions; *see* page 5 of the specification.

Improved abrasion resistance is also discussed in the specification from page 28 through page 33 with an abrasion resistance value of not more than 400 mg disclosed at page 32, lines 8-9. Lower, more preferred values are given on pages 33-36 and range generally from 350 to as low as 160 mg. The method of evaluating abrasion resistance relies on a Japan Industrial Standard and is described and discussed in more detail at page 56, item (14) when the various evaluation methods are summarized prior to the actual data.

Examples of the invention include Examples 25-31 and are reported at Table 11 at pages 95-96. Abrasion resistance values are specifically measured in Table 14 at page 99, Table 15, page 101 (comparative data), Table 18, page 104, Table 19, page 106 (comparative data), Table 22, page 109 and Table 23, page 111 (comparative data). It will thus be apparent that the specification itself is richly illustrated and exemplified in terms of abrasion resistance properties.

New claim 21 is based upon original claim 5 and includes an abrasion resistance of not more 400 mg based upon the description of the invention as noted above. Claim 22 states a value of 350 mg and find basis in the description at page 33, line 9. New claims 23-30 correspond to claims 6-13, respectively, and depend from new claim 21.

New claims 19 and 20 are based on the description at page 30 of the specification.

From the above it will be apparent that the new claims presented find ample basis in the description of the invention and are not directed to additional subject matter. Favorable consideration of these claims is solicited.

Response to Prior Art-Based Rejection

The sole issue raised in the outstanding Official Action is the patentability of claims 1-13 which the examiner argues are anticipated by published EP application 1 184 426. Applicants disagree with this conclusion. A perusal of the applied document will reveal that the compositions do not include or contemplate a surface coating layer composed of at least one material selected from a fatty acid, a fatty acid metal salt or a coupling agent. Nor does the applied document contemplate or suggest a means to improve abrasion resistance in a road marking material. Accordingly, the rejection must be withdrawn.

For completion of the record, counsel points out that applicants have illustrated their invention with various working examples and comparative examples illustrating the important improvements obtained in particular as to abrasion resistance. The specification includes several comparative examples.

The results presented in the original specification accompanied by the executed declaration signed by the inventors would have significant evidentiary weight, comparable to the weight given to an executed declaration. The results presented in the original declaration are not mere arguments, as alleged by the examiner. It is well established by the Federal Circuit that "the examiner must consider comparative data presented in the specification which is intended to illustrate the claimed invention in reaching a conclusion in regard to the obviousness of claims." *In re Margolis*, 785 F.2d 1029, 228 U.S.P.Q. 1123, 1129 (Fed. Cir. 1993).

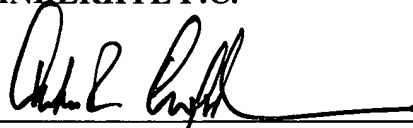
For the above reasons it is respectfully submitted that the claims of this application define inventive subject matter. Reconsideration and allowance are solicited.

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Respectfully submitted,

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